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| EXAMINER |
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SINGH, A

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| ART UNIT | PAPER NUMBER |
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1771

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DATE MAILED: 08/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/378,344

Applicant(s)

Rocke et al.

Examiner

Ms. Arti R. Singh

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on restriction on 05/08/2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above, claim(s) 11-22 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-10 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 20 Aug 1999 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Claims 11-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6 dated 05/25/2001.

Drawings

2. Appropriate figures (1) should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show 13b as described in the specification on page 1, line 15 onward, there is no 17A, only a #17 is shown. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing, since this is prior art, is it the barrier and the adhesive or just the barrier with a film lining? MPEP § 608.02(d). Correction is required.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: underneath figure 1, there is a legend, however "c" and "d" are not described in the specification. Correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent

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possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4 & 6-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7-9, 12, 16, 18, 20, 21, 24-29 & 31 of U.S. Patent No. 5,364,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent represent a species of the instant invention and therefore suggest the instant claims.

7. Claims 1-4 & 6-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10, 13-19, 21, 26 & 29-31 of U.S. Patent No. 5,204,156. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent represent a species of the instant invention and therefore suggest the instant claims.

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8. Claims 1-4 & 6-10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9 & 14-19 of U.S. Patent No. 5,268,212. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant patent and the application claim the same subject matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 & 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lumb et al. (US 5,364,678). Lumb et al. teach a stretchable, drapable, windproof, water resistant and water vapor permeable composite fabric. The composite fabric includes an inner fabric layer, an outer fabric layer and a non-porous hydrophillic barrier layer, said outer and inner layers and an essentially hydrophillic adhesive layer joining both the inner and outer layers with the barrier. The adhesive and the barrier layers are constructed to prevent air from passing through the fabric layers while allowing water vapor to travel there through by a process of absorption-diffusion-desorption, but restrict the passage of wind and liquid water (column 2, lines 9-23). The adhesive may be continuous or discontinuous (abstract & column 4, lines 11-65, column 5, line 1). The inner fabric layer maybe made from a variety of materials and may have a raised inner surface (column 2, lines 26-38). The barrier layer may be formed from a

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polyurethane (column 2, line 50 & column 4, line 32). The overall composite fabric is stretchable, windproof and water resistant (column 7, lines 12-25).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumb et al. (US 5,364,678). Lumb et al. disclose what is set forth above but do not specifically teach the adhesive to be foamed, however the Examiner takes Official Notice that it is well known in the art of adhesives to foam or add air into the adhesive mixture so as to use less adhesive and cover more area (unit per volume) of the desired surface that requires the adhesive. A person having ordinary skill in the art at the time the invention was made would have found it obvious to have used a foam adhesive for the reasons well known in the art along with it being more economical and to make it more porous. Further support for the use of foamed adhesives can be seen in Applicant's patent US 5,126,182.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,262,511, G.B. 1,321,643, US 4,863,788, US 5,364,678
US 5,268,212 US 5,204,156 US 5,126,182

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14. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Arti Singh, whose telephone number is (703) 305-0291. The Examiner can normally be reached Monday through Friday from 8 AM to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor Mr. Terrel Morris, can be reached at (703) 308-2414. A Facsimile center has been established in Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-5408. This location should be used in all instances when faxing any correspondence to Art Unit 1771. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1771.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



Ms. Arti Singh
Patent Examiner
Art Unit 1771
July 24, 2001



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700